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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 667,039	09 21 2000	Jacob Y. Wong	JSF 35.0011	8402

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EXAMINER

HESS, DANIEL A

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 07/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/667,039

Applicant(s)

WONG ET AL.

Examiner

Daniel A Hess

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--- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-14 and 16 is/are allowed.
- 6) ☒ Claim(s) 1-11, 15 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 15 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular claim 15 introduces no new limitations beyond claim 12, upon which it depends. The entire content of claim 15 is included in claim 12, part (3).

Claim 17 is exactly identical to claim 16, which is addressed below.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-3 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCabe (US 6,068,192) in view of Wong et al. (US 5,956,699).

Re claim 1: McCabe shows (column 5, lines 45-50) an electronic card that in addition has multiple electronic stripes. There is an account number (column 4, line 54) on the card. It is clear that if the card is to be used in swipe transactions, as is typical, this number must also be stored in the stripe, although it is not explicitly stated. The card is a credit card type (column 5, lines 60-65). Therefore each transaction request must submit data, including the account number, to a money source for approval of the payment card transaction. There is a data packet therefore that includes at least the credit account number.

McCabe fails to show the transmission of either a user id or a data packet that is separate from the credit account number.

Wong shows the following: During commerce, three items of data are sent (column 6, lines 25-30), order information (the claimed data packet), a special one-time-use card number (VICCN) and a user identifier.

In view of Wong's teachings, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known transmission of a user id and a data packet that is separate from the credit account number (i.e. order information) as taught by Wong because this information is typically the minimum of what is needed to complete a credit card transaction.

Re claim 2: McCabe, as noted above, has a magnetic stripe.

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Re claim 3: McCabe has (column 5, lines 48-50) three tracks on his card. Although he does not discuss what data goes on which track, the selection of a particular track does not make a material difference.

Re claims 7-9: McCabe fails to show that the user generates the number and that it is a unique customization variable. McCabe further fails to show the generation of a one-time-use payment card number.

Wong discloses (column 5, lines 24-25) a pin number for a card. This pin generates (column 5, lines 45-65) a unique customization variable that is used to generate a unique card number. Wong further shows that the number is one time use: it is used once and rendered invalid.

In view of Wong's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known user generated customization variable for a one-time-use number as taught by Wong into the teachings of McCabe because such a one-time-use number helps fight credit card fraud.

Re claim 10: McCabe fails to show a one-time payment number correlated with a sequence number for a sequence of one-time payment card numbers.

Wong shows (column 5, line 25) a permutation state number (PISN) (column 5, line 25) that is a sequence number for a sequence of one-time payment card numbers.

In view of Wong's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known one-time payment number correlated with a sequence number for a sequence of one-time payment card numbers as taught

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by Wong into the teachings of McCabe because this method of selecting one-time-use numbers avoids complicated on the fly algorithms that can be susceptible to hacking and attack.

Re claim 11: McCabe fails to show that the data packet is used to obtain the user sequence number.

Wong shows (column 5, line 25) that a permutation state derives from a user pin number. The user pin number would be part of a data packet that is stored on the card stripe.

In view of Wong's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known data packet used to obtain the user sequence number as taught by Wong into the teachings of McCabe because a user pin number is a good example of a piece of data from which a custom card number can derive, as Wong shows.

6. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCabe as modified by Wong as applied to claim 3 above, in further view of Neustein (US 5,192,947) and Lamensdorf (US 5,568,121).

McCabe as modified by Wong fails to show that the smart card executes a program to check battery life and then generates a warning signal if battery life is low.

Neustein (column 5, lines 59-61) that there is an indicator of a low battery on a card. Neustein does not show how this is achieved.

Lamensdorf (column, lines 20-28) shows how a low battery is detected: a program monitors power and creates a low battery signal.

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In view of the teachings of Neustein and Lamensdorf, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known executed of a program to check battery life and then generating a warning signal if battery life is low as taught by Neustein and Lamensdorf into the teachings of McCabe as modified by Wong because this can allow the user to replace a card before the power runs out.

*Allowable Subject Matter*

7. Claims 12, 13 14 and 16 are allowed.

The following is an examiner's statement of reasons for allowance:

Re claim 12: McCabe shows the following: There is an account number (column 4, line 54) on the card. It is clear that if the card is to be used in swipe transactions, as is typical, this number must also be stored in the stripe, although it is not explicitly stated. The card is a credit card type (column 5, lines 60-65). Therefore each transaction request must submit data, including the account number, to a money source for approval of the payment card transaction, as well as a user account number in an approval process.

McCabe fails to show that the smart card executes a program to check battery life and then generates a warning signal if battery life is low.

Neustein (column 5, lines 59-61) that there is an indicator of a low battery on a card. Neustein does not show how this is achieved.

Lamensdorf (column, lines 20-28) shows how a low battery is detected: a program monitors power and creates a low battery signal.

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In view of the teachings of Neustein and Lamensdorf, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known executed of a program to check battery life and then generating a warning signal if battery life is low as taught by Neustein and Lamensdorf into the teachings of McCabe as modified by Wong because this can allow the user to replace a card before the power runs out.

However, the second part of step 3, was not found in the prior art of record. The examiner did not find any art showing submitting a low battery signal to a money source in connection with a transaction approval process.

8. Claims 13, 14 and 16 depend from claim 12 and are therefore allowed.

9. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

#### ***Additional Remarks***

10. The lack of an art rejection with respect to claims 15 and 17 of this Office action is not an indication of allowable subject matter (i.e. even if claims 15 and 17 were rewritten or amended to overcome the rejection under 35 U.S.C. 112 discussed above.) As discussed above, these claims contain no new matter above claims 12 and 16 respectively, and therefore the content of claims 15 and 17 is already effectively addressed.



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***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A Hess whose telephone number is (703) 305-3841. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications

13. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



DH  
June 19, 2002

Daniel A Hess  
Examiner  
Art Unit 2876



THIEN M. LE  
PRIMARY EXAMINER